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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
10/748,759	12/30/2003	Nathaniel Blake Scholl	026014-002300US	2699		
20350	7590	01/05/2009	EXAMINER			
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				RETTA, YEHDEGA		
ART UNIT		PAPER NUMBER				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/748,759	SCHOLL ET AL.	
	Examiner	Art Unit	
	Yehdega Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 October 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,4,6-21 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,4,6-21 and 35 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/23/08</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Response to Amendment

This office action is responsive to amendment filed October 1, 2008. Applicant amended claims 1, 4, 9 and added claim 35. Claims 1, 2, 4, 6-21 and 35 are currently pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4, 6-21 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites a plurality of advertisement generators that use different algorithm **to automatically generate at least one advertisement to be included in an advertisement set**. The claim further recites *each generated advertisement set* having at least one different advertisement. The claim recites the advertisement generators, with the algorithm, is for generating advertisement, not for generating advertisement set. The claim recites that generated advertisement art to be included in an advertisement set however does not teach the advertisement set are generated by the advertisement generators or the algorithm. The claim further recites that the advertisement manger receives from the advertisement generators the advertisement set. It is unclear if the generators are for generating advertisement set or just for generating the advertisement. Since the claim recites a plurality of advertisement generators are to generate at least **one** advertisement to be included in **an advertisement set**, it is also unclear if the plurality of generators each create one advertisement or one advertisement set or all the

generators use different algorithm to generate at least one advertisement to be included in only one advertisement set.

Claim 9 also recites automatically *generating at least one advertisement for each of a plurality of advertisement sets* using a different algorithm for each advertisement set, each algorithm specifying at least one creative aspect of the at least one advertisement generated by that algorithm, *each advertisement set being generated for the same advertiser and the same keyword*, and specifying at least one *automatically generated advertisement*, the keyword, and a bid amount. The claim does not recite generating advertisement set. The claim recites *generating advertisement* for each advertisement set. Therefore, it unclear whether the “advertisement” or the advertisement set” is generated using the algorithm.

Claim 35 is also rejected for the same reason stated above in claim 9.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calabria et al. (US 2005/0137939) in view of Bronnimann et al. (US 2004/0044571).

Regarding claims 1, 2, Calabria teaches an advertisement generators that each use a different algorithm to automatically generate an advertisement sets for advertiser (see [0052]-[0055] [0121]); each advertisement set having a keyword and an advertisement; a fee calculator that calculates fee amounts for advertisements based on anticipated profitability of the

advertisement sets (see [0013], [0019] – [0023] an advertisement submitter that sends to an advertisement placement service a request to place the advertisement along with content associated with the keyword at the fee amount of an advertisement set; and an advertisement manager that receives from the advertisement generator advertisement sets, receives from the fee calculator a fee amount for each advertisement set, and provides to the advertisement submitter the selected advertisement sets that each have an advertisement, a keyword, and a at the fee amount (see [0035] – [0040], [0044]- [0047], [0109]). Calabria does not explicitly teach generating advertisement sets wherein each generated advertisement set having different advertisement for a single keyword, it is taught in Bronnimann. Bronnimann teaches advertiser generating a plurality of advertisement sets, each advertisement set including different advertisement for a keyword and tracking click-through rates to determine which of the advertisement was more efficient (see [0010]-[0016], [0048] – [0054]). It would have been obvious to one of ordinary skill in the art at the time of the invention to generate more than one advertisement for a single keyword to track the most efficient advertisement for the keyword in order to maximize relevancy and effectiveness of the advertisement as taught in Bronnimann.

Examiner would like to point out that no patentable weight is given to the language “*each algorithm specifying at least one creative aspect* of a respective advertisement generated for the advertiser and the keyword, since it is merely a language that is not used. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*,

703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP '2106.

Regarding claims 4, 7, 8, Calabria teaches the advertisement manager selects one of the multiple advertisement sets based *at least in part on determined likelihood* of users selecting the advertisement when it is placed along with a content associated with the keyword; a database containing statistics relating to placements of advertisements and wherein the fee calculator determines anticipated profitability based on analysis of the statistics; wherein the statistics include average cost-per-click of an advertisement and average revenue-per-click (see [0120]-[0123],[0133]- [0147]). Bronnimann also teaches selecting advertisement sets, based on the determined likelihood (tracking click-through rates to determine which of the advertisement was more efficient) (see [0010]-[0016], [0048] – [0054]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to select the advertisement based on the analysis in order to select the most effective advertisement.

Regarding claim 6, Calabria teaches multiple advertisement submitters where each advertisement submitter is associated with an advertisement placement service (see [0153]).

Claims 9-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bronnimann et al. (US 2004/0044571) in view of Calabria et al. (US 2005/0137939).

Regarding claims 9, 10, 13-18 and 35, Bronnimann teaches advertiser generating a plurality of advertisement sets, each advertisement set including different advertisement for a keyword (see [0010]; specifying a bid amount for each advertisement ([0004], [0010]; wherein the bid amount is based on advertising metrics, profit, revenue, etc; determining whether an

advertisement set is currently submitted to an advertisement placement service for the keyword; submitting to the advertisement placement service a request to place the advertisements specified by the selected advertisement sets; analyzing the effectiveness of the placed advertisement, the effectiveness of the placed advertisement being based on at least financial benefit of placing the advertisement; and subsequently selecting advertisement sets for placement of advertisements based on the analysis, so that the selected advertisement set does not conflict with an advertisement set that is currently submitted to the advertisement placement service for the keyword (see [0048]-[0054]). Bronnimann does not explicitly teach when an advertisement set is not currently submitted to the advertisement placement service for the keyword, Selecting one of the generated advertisement sets for submission to the advertisement placement service.

Calabria teaches selecting a keyword combination, providing an estimate of return on investment for the bid associated with the keyword combination analyzing; the effectiveness of the placed advertisements for each-the advertisement sets, the effectiveness of an advertisement being based on at least financial benefit of placing the advertisement; and selecting advertisement sets for placement of advertisements based on the analysis (see [0035]-[0040], [0044]- [0047], [0052]-[0055], [0109], [0121]). It would have been obvious to one of ordinary skill in the art at the time of the invention to evaluate the effectiveness of each advertisement ant to select the most effective advertisement of Bronnimann, based the evaluation of each advertisement, in order to maximize profit.

Regarding claims 11, 12 and 19, Bronnimann teaches placing the advertisement with search result associated with a search term matching the keyword; placing with content associated with keyword (see [0004]-[0010], [0041]-[0044]).

Regarding claims 20 and 21, Bronnimann does not explicitly teach the generated advertisement sets are based on frequency or desirability of keywords. Official notice is taken that is old and well known in the art of search engines to determine search terms based on frequency or desirability of the keyword in a content. It would have been obvious to one of ordinary skill in the art at the time of the invention to know that the advertiser's of Bronnimann would select the keyword based on frequency or desirability of the keyword in order to provide the most relevant content or information to the user.

Response to Arguments

Applicant's arguments filed October 1, 2008 have been fully considered but they are not persuasive.

Applicant argues that "*Calabria* does not, however, teach or suggest "a plurality of advertisement generators" as recited in Applicants' claim 1 as amended, where each advertisement generator uses "a different algorithm to automatically generate at least one advertisement to be included in an advertisement set for the advertiser and the keyword, each algorithm specifying at least one creative aspect of a respective advertisement generated for the advertiser and the keyword". However the claim does not recite whether the generating of the advertisement is based on the specified creative aspect. As indicated above no patentable weight is given to the language since there is no connection between the generation of the advertisement and what is specified in the algorithm. The added language does not change the structure of the advertisement generators. Applicant also asserts that the claim also recites "an advertisement

manager that "receives from the advertisement generators the generated advertisement sets" and receives "a fee amount for each of the generated advertisement sets", and "selects one of the generated advertisement sets for submission". Applicant further argues that, *Calabria* instead teaches only selecting an *existing ad*, matching candidate keywords with the selected ad, and determining a bid price for the combination. *Calabria* thus does not teach or suggest " a plurality of advertisement generators" as recited in Applicants' claim 1. If applicant is arguing that according to the claim the advertisement is generating by the generators and is not stored (is not a pre existing advertisement) the claim however does not positively recite the advertisement are generated (created) on the spot and then provided to the advertisement manager without being stored. Claim 9 also recites "automatically generating at least one advertisement for each of a plurality of advertisement sets using a different algorithm for each advertisement set" which could mean that that the advertisement is generated and stored and later selected as an advertisement set for a keyword.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622